

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

A replacement title has been provided, as suggested by the Examiner.

Claims 1-17 remain in this application. Claims 18-20 have been added without adding any new matter. Claims 3-5 are indicated as being allowable, along with the claims dependent thereon.

Claims 3-5 were rejected under 35 U.S.C. §112, second paragraph, for being indefinite. The claims have been amended, making the rejections moot. Accordingly, claims 3-5 are allowable.

Claims 2, and 6/2 were rejected under 35 U.S.C. §102(b) as being anticipated by Weiland *et al.* (U.S. 5,590,408). Claim 1 was rejected under 35 U.S.C. §103(a) as being unpatentable over Weiland in view of Kitade *et al.* (U.S. 6,138,033). For the following reasons, the rejection is respectfully traversed.

Claim 2, as amended, recites a radio communication device having:

a transmitted electric power setting part for receiving a transmitted *electric power control bit* sent from the other station, said setting part utilizing said bit for setting a set transmitted electric power

(emphasis added). Claim 1, as amended, cites similar limitations. Weiland fails to teach any such control bit. In fact, Weiland makes clear that the disclosed device utilizes an “open loop power control” that is “performed by the radio itself without control input from the cells” (col. 3, lines 64-67). Thus, the reference not only does not teach the cited feature, but actually teaches away from such a feature. Furthermore, Kitade also teaches the use of an “open loop” power control, and fails to teach the use of any power control bit. Accordingly, claims 1 and 2 are patentable over the references.

Furthermore, claim 1 recites the radio communication device also including:

an error calculating part for obtaining an error between the detected transmitted electric power of the communication device and the set transmitted electric power value [and]
a buffer unit for receiving said error and said transmitted electric power setting value and for outputting a correction signal used for correcting the gain of the variable gain amplifier for *smoothly changing* the gain when the set transmitted electric power is set to put the transmitted electric power *over* a threshold value

(emphasis added). Neither of the cited references teaches such a feature. Instead, Weiland teaches a device that attempts to avoid letting a transmitted power exceed a maximum value (see col. 4, line 37 to col. 5, line 4). Thus, the invention prevents the power being set above a maximum value. There is no teaching of “smoothly changing” the gain when the power is set *over* a threshold value. Kitade fails to overcome this shortcoming. Accordingly, claim 1 is patentable over the references.

Similarly, claim 2 recites a radio communication device include a similar error calculating part and also including

an error integrating part that determines whether the calculated error is integrated in accordance with the decided result of whether the set transmitted electric power is above or below the threshold value;
and
an adding part for *adding the integrated result* to the gain control signal for obtaining a result for controlling the gain of the variable gain amplifier”

(emphasis added). Again, Weiland and Kitade fail to teach such error integrating and adding functions. Note particularly that the references fail to teach any dependency of integration based on a threshold value comparison. Thus, claim 2 is patentable over the references for this reason as well.

Claims 6-17, which depend on one or more of claims 1-5, are thus patentable over the references for at least the same reasons as the parent claims. New claims 18-20 are patentable over the references for similar reasons as discussed above, for similar reasons

as the allowed claims, and in particular because no “threshold”, as used by the claims, is taught or suggested by the references.

Finally, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the reference (MPEP §2143.01). The mere fact that references can be combined or modified, alone, is not sufficient to establish prima facie obviousness (Id.). The prior art must also suggest the desirability of the combination (Id.). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (Id.).

Merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

“To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person.” (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious “as a whole”, not as a piecemeal combination of elements from various references.

Accordingly, the rejections for obviousness are not supported by the Office action and thus the rejections are improper, and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the

examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 37688.

Respectfully submitted,

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